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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/571,582	03/10/2006	Kouichi Kitahata	1422-0712PUS1	9795
2292	7590	01/19/2010	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				ORWIG, KEVIN S
ART UNIT		PAPER NUMBER		
1611				
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01/19/2010			ELECTRONIC	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/571,582	KITAHATA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Kevin S. Orwig	1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 December 1899.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-4 and 6-17 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-4 and 6-17 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____.   | 6) <input type="checkbox"/> Other: _____ .                        |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. The amendments filed on Nov. 4, 2009 have been entered.

### ***Status of the Claims***

Claims 1-4 and 6-17 are pending. Claim 1 has been amended; claim 5 is cancelled; claims 15-17 have been added. Claims 1-4 and 6-17 are now under consideration. This Office Action is in response to the request for continued examination filed on Nov. 4, 2009.

### ***OBJECTIONS/REJECTIONS MAINTAINED***

The rejection of claims 1-4, 6, 8, 9, 11 under 35 U.S.C. 102(b) is maintained as discussed below.

The rejections of claims 1, 7, 10, and 12-14 under 35 U.S.C. 103(a) are maintained as discussed below.

***Claim Rejections - 35 USC § 102 (Maintained)***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-4, 6, 8, 9, 11, and new claim 16 are rejected under 35 U.S.C. 102(b) as being anticipated by SHIO (WO 98/14399, Published Apr. 9, 1998; as evidenced by U.S. 6,511,668) as evidenced by Sodium Silicates data sheet (<http://chemicalland21.com/industrialchem/inorganic/SODIUM%20SILICATE.htm> retrieved on 1/11/10).**

WO 98/14399 to Shio is published in Japanese. Thus, the patent resulting from the national stage entry of the international application is used herein as an English language equivalent. Column and line numbers refer to the '668 patent.

1. Shio discloses mesoporous silica and associated compositions that are useful as a carrier for cosmetics, pharmaceutical drugs and perfumes (abstract; col. 2, lines 24-34; col. 5, lines 57-59; Table 2; claim 1). Shio's compositions are obtained by a process comprising dissolving a silicate in the presence of a cationic surfactant (i.e. an organic raw material) (abstract; col. 2, lines 35-40; col. 5, lines 28-41 and 60-67). The instant application defines the term "water glass" as sodium silicate (see par. [0073] of the pre-grant publication), which is consistent with how the term is known and used in the art (see evidentiary reference regarding sodium silicates). Shio teaches the use of sodium silicate (i.e. "water glass") (pars. [0071] and [0072]; Table 1). Shio teaches that X-ray

diffraction studies showed a hexagonal structure for the silica pores (Figs. 9, 12, 13, and 18; col. 20, lines 48-52), which is completely consistent with the data provided by applicants in the rule 132 affidavit submitted Feb. 26, 2009 to illustrate this very property (compare '668 Fig. 9 with Fig. 3 of the affidavit). Shio teaches an embodiment wherein the mesoporous powder holds a perfume (i.e. a volatile substance) (title; abstract; Fig. 21; col. 1, lines 62-65; col. 3, lines 32-34; col. 23, line 57 to col. 24, line 52; claim 27). Shio teaches that the inventive silicas have a specific surface area of 900-1100 m<sup>2</sup>/g (Table 5). Shio teaches that mesoporous powders have pore sizes between 2-50 nm and that the disclosed silicas have a pore size of 30-35 Å (3-3.5 nm) (Table 5; col. 1, lines 16-19; Figs. 11 and 15).

2. Regarding claim 2, Shio teaches cosmetic preparations comprising the porous silicas of the invention and teaches that the silica powders can be compounded as an emulsion or dispersion and further teaches that other ingredients generally compounded into external preparations, such as surfactants (i.e. emulsifiers) can be compounded with the invention (col. 14, lines 28-51). See also Compounding Examples 4-12, 4-13, 4-16, 4-17, and 15), which are all cosmetic compositions using emulsifiers such as various fatty acid esters.

3. Regarding claim 4, Shio teaches that the particle size of the powder can be adjusted with extreme ease (col. 23, lines 55-56) and teaches that embodiments that preferably comprise particles with an outer diameter of 20-200 nm (col. 2, lines 11-15; claim 1). Thus, Shio anticipates claims 1-4, 6, 8, 9, 11, and 16.

***Response to Arguments***

Applicants' arguments have been fully considered but are not persuasive. Applicants assert that the porous silica of Shio is not obtained by the claimed process and does not comprise water glass as a raw material (response, p. 6).

As discussed above, Shio explicitly teaches sodium silicate (i.e. water glass as defined in the instant specification). Applicants are incorrect in their assertion that Shio fails to teach the claimed process. See Shio at abstract; col. 2, lines 35-40; col. 5, lines 25-41 and 60-67. Shio anticipates the rejected claims.

***Claim Rejections - 35 USC § 103 (Maintained)***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The instant claims are drawn to a substance-supporting hexagonal porous silica with a specific surface area, pore size, and particle size. Hexagonal porous silicas meeting all of the instant requirements are well-known in the art, and the only "inventive concept" of the instant claims appears to be the selection of an appropriate substance to be carried on (i.e. supported by) such silica. This aspect of the instant application is not inventive as selection of an appropriate substance is well within the purview of the skilled artisan to make based on the intended use of the substance-carrying silica.

**Claims 1, 7, 10, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shio in view of YOSHIMOTO (JP 07-173452; Published Jul. 11, 1995; Ref. BB on IDS dated Mar. 10, 2006).**

4. Shio discloses mesoporous silica and associated compositions that are useful as a carrier for cosmetics, pharmaceutical drugs and perfumes (abstract; col. 2, lines 24-34; col. 5, lines 57-59; Table 2; claim 1). Shio does not explicitly teach the other supported substances instantly claimed (i.e. menthols, thermal substances, plant polyphenols, and organic colorants). Nonetheless, as stated above, given the state of the art, it would have been *prima facie* obvious to one of ordinary skill in the art at the

time of the invention to select any one of these agents depending on the desired use of the silica composition.

5. For example, Yoshimoto discloses the use of fine porous inorganic particles such as silica to enclose various functional substances including antibacterials, perfumes, biocides, and agricultural chemicals (paragraph [0001]). Furthermore, Yoshimoto teaches that such use of porous silica is conventional (paragraph [0002]). Yoshimoto teaches the use of compounds including menthol (a known cooling substance) (paragraph [0015]) and camphor (paragraph [0013]), which is a "thermal substance" as defined in paragraph [0136] of the instant specification (pre-grant publication).

6. In light of these teachings, it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to include either menthol or camphor, in the porous silica compositions of Shio to provide a coolant composition, or as a perfume or antimicrobial composition as taught by Yoshimoto. One would have had a high expectation of success in doing so since Shio teaches that the silicas are useful as carriers for cosmetics, pharmaceutical drugs and perfumes. Thus, one would have expected to arrive at functional compositions for any of these purposes by incorporating an appropriate cosmetic or bioactive agent based on the desired use of the composition. The combination of Shio and Yoshimoto renders claims 1, 7, 10, and 12 obvious.

### ***Response to Arguments***

Applicants' arguments have been fully considered but are not persuasive. Applicants assert that sustained release cannot be expected from the silicas of Shio

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because the adsorption is weak. Based on this assertion, applicants further argue that instantly claimed invention features "superior and unexpected properties" (response, p. 7).

However, Shio teaches that,

"A mesoporous powder in accordance with the present invention has a protection effect and a controlled release effect for an inner material because the mesoporous powder has a superb oil absorption property and a large pore. Also, the mesoporous powder is expected to apply for a pharmaceutical carrier and a column packing or cosmetics and foods." (col. 9, lines 15-21, emphasis added)

Thus, applicants' assertion is refuted by Shio's direct teachings. Shio's silicas are clearly suitable for controlled release of the materials carried therein and have superb adsorption properties, in contrast to applicants' assertion.

Applicants argue that the raw materials used in the instant invention differ from those of Shio. Specifically, applicants assert that the instant invention uses water glass with a SiO<sub>2</sub>/Y<sub>2</sub>O ratio of 2 or more, but Shio uses water glass with a SiO<sub>2</sub>/Y<sub>2</sub>O ratio of 0-2 (response, p. 7).

In response to applicants' argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the particular SiO<sub>2</sub>/Y<sub>2</sub>O ratio referred to in the arguments/Declaration) is not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The instant claims do not recite any SiO<sub>2</sub>/Y<sub>2</sub>O ratio, let alone that this ratio is 2 or more. Moreover, there does not even appear to be support for such a limitation in the specification as filed.

Regarding the Rule 1.132 Declaration filed by applicants on, Nov. 4, 2009, the

above discussion also applies thereto as well. Shio clearly teaches that the disclosed silicas are suitable for controlled release. No unexpected results have been demonstrated. It is also noted that applicants have only claimed the broad genus of "water glass", which includes water glass having any SiO<sub>2</sub>/Y<sub>2</sub>O ratio. The claims are not limited to water glass having a ratio of 2 or more.

**Claims 1 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shio in view of TERASE (JP 05-070120; Published Mar. 23, 1993; Ref. BC on IDS dated Mar. 10, 2006).**

7. Shio discloses mesoporous silica and associated compositions that are useful as a carrier for cosmetics, pharmaceutical drugs and perfumes (abstract; col. 2, lines 24-34; col. 5, lines 57-59; Table 2; claim 1). Shio does not explicitly teach porous silicas as carriers for plant polyphenols. Nonetheless, as stated above, given the state of the art, it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to select any one of these agents depending on the desired use of the silica composition.

8. For example, Terase discloses the use of porous silica to adsorb turbidity causing substances from beer (pars. [0005], [0006], [0016], and [0018]). The substances taught to be removed by the silica include polyphenols produced from fermentation of barley and hops (i.e. plant polyphenols) (pars. [0002], [0003], [0007], and [0018]). In light of these teachings, it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to use the porous silicas taught by Shio to adsorb plant polyphenols.

9. If one wanted a means to remove unwanted polyphenols from, for example, beer, one would have been motivated to use the porous silicas of Shio with a high expectation of success since Terase teaches porous silica is useful for this purpose. The combination of Shio and Terase renders claims 1 and 13 obvious.

**Claims 1, 2, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shio in view of ANDERSON (U.S. 6,096,469; Issued Aug. 1, 2000).**

10. The teachings of Shio are presented *supra*. Shio teaches the use of pigments compositions of the invention (col. 14, line 50). While this teaching alone would be sufficient to guide an ordinary artisan to include an organic colorant in the silica compositions, this rejection is made under obviousness since Shio does not describe such an embodiment sufficiently to be anticipatory.

11. In addition to Shio, Anderson discloses surfactant templated mesporous (STM) particles as receptors for ink (abstract; col. 1, lines 62-64; col. 2, lines 34-38; claims 1-6 and 14) that may include additional surfactant (i.e. an emulsifier) (col. 10, lines 54-67). In light of these teachings, it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to use an organic colorant such as a dye, pigment, or ink as taught by Anderson in conjunction with the porous silicas of Shio. One would have had a high expectation of success since Shio directly teaches the use of pigments.

***NEW GROUNDS OF REJECTION***

***Claim Rejections - 35 USC § 112 (1<sup>st</sup> Paragraph)***

**Claims 15 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The response filed Nov. 4, 2009 has introduced NEW MATTER into the claims. Amended claim 15 recites, *inter alia*, a porous silica comprising an organic raw material and water glass. Applicants point to p. 17, lines 3-12 as allegedly providing support for this limitation. However, this portion of the specification does not provide proper support for new claims 15 and 17. Rather than providing support, the portion of the specification pointed to by applicants makes it clear that the porous silica is formed by removing the organic substance template (e.g. surfactant). Since the porous silica is formed by removing the organic raw material, it cannot, by definition, comprise the same. In the absence of support for a porous silica comprising both an organic raw material and water glass, the limitation, "...wherein the porous silica comprises an organic raw material and water glass" is new matter and must be removed from the claims.

Instant claims 15 and 17 now recite limitations, which were not clearly disclosed in the specification as filed, and now change the scope of the instant disclosure as filed.

Such limitations recited in amended claims 15 and 17, which did not appear in the specification, as filed, introduce new concepts and violate the description requirement of the first paragraph of 35 U.S.C 112. Applicant is required to provide sufficient written support for the limitations recited in present claims 15 and 17 in the specification or claims, as-filed, or remove these limitations from the claims in response to this Office Action.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shio.**

12. The teachings of Shio are presented *supra*. As noted above, claims 15 and 17 introduce NEW MATTER into the application since the claims are not supported for the embodiment wherein a porous silica comprising the surfactant (i.e. organic raw material) and water glass are present along with a supported substance (that is, before removal of the surfactant template).

13. Shio teaches dissolving sodium silicate (i.e. water glass) in a solution in the presence of a cationic surfactant (abstract; col. 2, lines 35-40; col. 5, lines 25-41 and 60-67). Shio teaches that after formation of the porous silica, a large amount of surfactant remains (col. 6, lines 9-10). Since Shio also teaches that the silicas can be compounded as emulsions or dispersions (col. 14, lines 28-51), it would have been *prima facie* obvious to one of ordinary skill in the art at the time of the invention to add the medicinal or cosmetic substance to be carried at this point (before removal of the surfactant), to provide a medicinal or cosmetic emulsion. One would have been motivated to do so since the ordinary artisan would recognize that this would eliminate the need to remove the surfactant, and thus result in a simpler manufacturing process (with fewer steps). Claims 15 and 17 are obvious over Shio.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

### **U.S. Patent Application No. 10/588,453**

Claims 1-4 and 6-17 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4-8 of copending Application No. 10/588,453 in view of Shio and Yoshimoto or Terase or Anderson. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the '453 claims renders obvious that of the instant claims. The '453 claims recite substantially the same product, differing mainly in the way the product is used. As stated *supra*, silicas as claimed are well known and claiming a known use for the same is not inventive. The difference between the two claim sets is that the '453 claims do not recite water glass. However, Shio teaches this element as well as the claimed process for the production of the porous silicas. The substances carried thereon are either taught by the '453 claims or obvious from the other references.

Claims 1-4 and 6-17 are directed to an invention not patentably distinct from claims 1, 2, 4-8 of commonly assigned 10/588453. Specifically, see above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned 10/588,453, discussed above, would form the basis for a rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

### ***Conclusion***

Claims 1-4 and 6-17 are rejected. No claims are currently allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin S. Orwig whose telephone number is (571)270-5869. The examiner can normally be reached Monday-Friday 7:00 am-4:00 pm (with alternate Fridays off). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached Monday-Friday 8:00 am-5:00 pm at (571)272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin S Orwig/

/David J Blanchard/  
Primary Examiner, Art Unit 1643